

REMARKS**Claim Amendments**

Claims 31 and 32 are amended to correct typographical errors. Claims 1, 27, 28, and 29 are amended to recite "wherein the wireless terminals operate as normal wireless terminals in the wireless communication system" or similar language. Support for this claim amendment is found, for example, in the Specification at page 3, lines 8-11 and page 4, lines 11-17.

Claim Rejections under Double Patenting

Claims 1-34 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of U.S. Patent No. 6,496,700.

A terminal disclaimer in compliance with 37 C.F.R. 321(c) is provided along with this response limiting the term of the pending application and indicating common inventorship and ownership of the pending application and the cited patent.

Claim Rejections under 35 U.S.C. § 102***A. The Jonsson Reference***

Claims 1-34 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,513,246 to Jonsson et al. (hereinafter "Jonsson"). Jonsson describes a method for mobile station handoff between a plurality of base stations of a cellular mobile radio-telephone system (column 2, lines 32-35). The method locates a mobile station with respect to cell boundaries using measurements of signal strength and path-loss and then initiates a handoff to a candidate cell according to radio-signal criteria (column 2, lines 35-48). Furthermore, the method uses path-loss as a primary criterion for handoff of a mobile station from one base station to another, unless the path-loss fails to meet a minimum

threshold for handoff, in which case the method utilizes signal strength to determine if handoff should occur (column 2, lines 48-55).

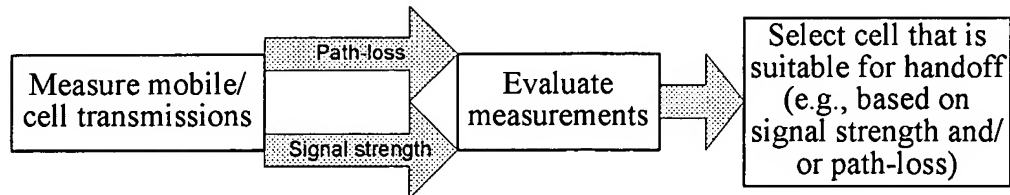


Diagram 1 – Jonsson Handoff Method

Jonsson fails to disclose all the limitations of the pending claims, and therefore does not establish a *prima facie* case of anticipation. Claim 1 is directed to a method of calculating a system organization parameter for a wireless communication system. For example, claim 1 recites, *inter alia*, "intermittently measuring a path loss related characteristic between a base station and one or more wireless terminals . . . thereby forming a measured path-loss related characteristic measurement," "determining a signal propagation characterization that relates the measured path loss-related characteristic measurement to the base station and the geographic location of one or more wireless terminals," and "altering the system organization parameter for the wireless communication system based on the signal propagation characterization." Claims 27-29 recite similar language, including "adjusting at least one system organization parameter based on the characterization of signal propagation" (claim 28) and "altering the system organization parameter from the stored path loss-related characteristics" (claim 29).

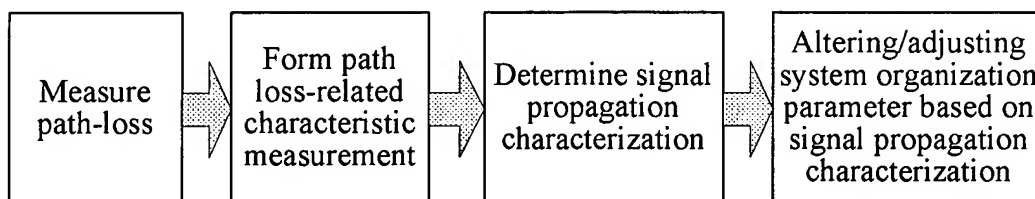


Diagram 2 – Example of Applicants' Techniques

While both applicants' techniques and Jonsson's method both consider path-loss measurements, the similarity between the techniques stops there. For example, Jonsson does not disclose "calculating" or "determining" a "system organization parameter," let alone "determining a signal propagation characterization" that relates a path loss-related characteristic measurement to a base station and to a geographic location of a wireless terminal. Nor does it disclose "altering a system organization parameter" for a wireless communication system "based on the signal propagation characterization." Instead, Jonsson describes a method for identifying the location of a mobile station from one cell to another cell by applying path loss and signal strength measurements of the mobile station's location to boundary criteria to determine if handoff is necessary (column 4, line 38 – column 5, line 20). Further, even if performing a "handoff" is somehow considered analogous to altering/adjusting a system organization parameter, except for measuring path-loss, Jonsson's handoff technique fails to resemble any of applicants' system organization parameter techniques.

Jonsson does not disclose each and every aspect of claims 1, 27, 28, or 29, and therefore applicants submit that the claims are not anticipated by Jonsson. Since claims 2-26 depend on claim 1 (or its dependents) and claims 30-34 depend on claim 29 (or its dependents), applicants submit that Jonsson does not anticipate claims 1-34 and, therefore, requests that the rejection of claims 1-34 as being anticipated by Jonsson be withdrawn.

B. *The Chawla Reference*

Claims 1-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,878,328 to Chawla et al (hereinafter "Chawla"). Applicant notes that a rejection under 102(b) is improper because the effective date of Chawla (December 21, 1995) is less than one year before applicants' priority date (April 4, 1996). Accordingly, applicants respectfully request that the rejection under 102(b) be withdrawn.

Assuming that the rejection under 102(b) will be withdrawn and replaced with a rejection under 35 U.S.C. § 102(e), applicants herein address an anticipated rejection under 35 U.S.C. § 102(e). The pending claims now recite, among other things, "measuring a path loss-related characteristic between a base station and one or more wireless terminals of the wireless communication system . . . wherein the one or more wireless terminals operate as normal wireless terminals in the wireless communication system," or similar language. This technique allows the path loss to be measured during normal operation of the wireless communication system. In contrast, Chawla discloses taking path loss measurements using "test units" located in various regions. Accordingly, Chawla does not disclose every element of applicants' technique.

A rejection under 35 U.S.C. § 103(c) would also be improper. In particular, the subject matter of U.S. No. 5,878,328 is commonly owned by the assignee of the pending application. Under 35 U.S.C. § 103(c), "subject matter developed by another person, which qualifies as prior art only under one or more subsections of (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention, at the time the invention was made, is owned by the same person or subject to an obligation of assignment to the same person (see MPEP 706.02(I)(2)). Here, at the time the applicants' invention was made, both the subject matter disclosed in U.S. Patent No. 5,878,328 and the applicants' invention were subject to an obligation of assignment to AT&T Wireless Services, Inc. of Middletown, N.J.

C. *Similar Rejection*

As noted by the Examiner, the current rejections under 35 U.S.C. § 102 are similar to rejections raised by Examiner Lester Kincaid in an Office Action mailed November 26, 2001, for parent patent application no. 08/628,214. Applicants' successfully addressed those rejections in an Office Action Response, dated February 22, 2003, which led to a Notice of Allowance and the ultimate issue of U.S. Patent No. 6,496,700. Because the current application shares aspects of the subject matter of U.S. Patent No. 6,496,700,

applicants refer Examiner Ferguson to the February 22, 2003 Response for additional reasons as to why the pending claims should be allowed.

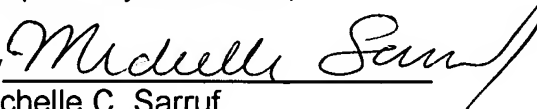
Conclusion

In view of the above amendments and stated arguments, applicants request reconsideration and withdrawal of the rejections set forth in the Office Action dated November 30, 2004. Applicants submit that the claims pending in the application as amended comply with the requirements of 35 U.S.C. § 102 and 35 U.S.C. § 103 and are patentably distinct over the prior art. A Notice of Allowance is therefore requested. If the undersigned attorney has overlooked a relevant teaching in the cited references, the Examiner is requested to point out specifically where such teaching may be found.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 101948008US2 from which the undersigned is authorized to draw. If Examiner Ferguson believes a telephone conference would expedite the prosecution of the application, the Examiner is encouraged to call the undersigned at (206) 359-3925.

Dated: February 28, 2005

Respectfully submitted,

By 
Michelle C. Sarruf

Registration No.: 55,828
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000
(206) 359-7198 (Fax)
Attorney for Applicants